

### **REMARKS**

Upon entry of the amendments, claims 30 to 50 will be pending.

#### **A. Regarding the Amendments**

Claim 45 is cancelled herein without disclaimer and without prejudice. Claim 30 has been amended to further comprise the step of recovering the high molecular weight nucleic acid from the liquid medium. This amendment is supported, for example, in the specification at page 26, line 22-27, and at page 37, lines 10-32. Claims 46, and 48-50 have been amended to more clearly show their dependence on claim 30. The amended claims are supported by the specification and the original claims and do not add any new matter. The amendments do not require a new search or consideration because the claims as amended encompass subject matter that has been of issue in this case. It is further submitted that the amendments claims place the claims in condition for allowance, or in better condition for appeal. As such, entry of the amendments is respectfully requested.

#### **B. Double Patenting Rejection**

Claims 32 and 34 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 7 and 8 of U.S. Patent No. 6,235,501. The rejection is respectfully traversed.

Statutory type double patenting exists if the inventions in question are identical in subject matter. If there is an embodiment of the invention that falls within the scope of a claim in one of either the patent or the application, but that does not fall within the scope of a claim in the other, the same subject matter is not defined and statutory double patenting does not exist (MPEP § 804). Here, claim 30 has been amended such that claims 32 and 34 are no longer co-extensive in scope compared to claims 7 and 8 of the '501 patent. In particular, claims 32 and 34 of the present invention, depending from amended claim 30, are directed at a method further comprising recovering the high molecular weight nucleic acid from the liquid medium. This step

is not found in claims 7 and 8 of the '501 patent. Accordingly, it is respectfully requested that this rejection of the claims be removed.

Claims 30-50 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,235,501, in view of U.S. Patent No. 5,464,773 and EPO 0 288 618. The rejection is respectfully traversed.

A Terminal Disclaimer, disclaiming any term of a patent issuing from the subject application that may extend beyond the term of the '501 patent, is submitted herewith. Accordingly, it is respectfully requested that this rejection of the claims be removed.

Application No.: 09/863,137  
Applicant: Gautsch, et. al.  
Filed: May 22, 2001  
Page 8

PATENT  
Attorney Docket No.: QBIO1140-2

### CONCLUSION

In summary, for the reasons set forth herein, Applicants maintain that the claims clearly and patentably define the invention, respectfully request that the Examiner reconsider the various grounds set forth in the Office Action, and respectfully request the allowance of the claims which are now pending.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's representative can be reached at (858) 677-1456. Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,

Date: \_\_\_\_\_

9/17/03

Lisa A. Haile

Lisa A. Haile, J.D., Ph.D.

Registration No. 38,347

Telephone: (858) 677-1456

Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP  
4365 Executive Drive, Suite 1100  
San Diego, California 92121-2133

**USPTO Customer Number 28213**